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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92047536
Party	Plaintiff Distillerie Stock U.S.A. Ltd. Distillerie Stock U.S.A. Ltd. ,
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Attachments	Amended Petition.pdf (5 pages)(173721 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 2,452,996
Registered May 22, 2001
Mark: BORU

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Distillerie Stock U.S.A. Ltd.,

Petitioner,

– against –

Castle Brands Spirits Company Limited,

Respondent.
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: Cancellation No. 92047536
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: **AMENDED PETITION**
: **FOR CANCELLATION**
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:
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TO THE COMMISSION FOR TRADEMARKS:

Petitioner, Distillerie Stock U.S.A. Ltd., believes it is being, and will continue to be, damaged by the existence of Registration No. 2,452,996 for the Mark BORU and, no answer having yet been filed in response to the petition for cancellation herein, submitted May 9, 2007, Petitioner, pursuant to Fed.R.Civ.P. Rule 15(a) and 37 C.F.R. Section 2.115, hereby submits this amended petition for cancellation of the same pursuant to Section 14 of the Trademark Act of 1946, as amended (the “Lanham Act”), 15 U.S.C. § 1064.

As grounds for cancellation, Petitioner alleges that:

1. Petitioner Distillerie Stock U.S.A. Ltd. (“Distillerie Stock”) is a corporation duly organized and existing under the laws of the State of New York, with its executive offices at 58-58 Laurel Hill Boulevard, Woodside, New York 11377.

2. Registrant Castle Brands Spirits Company Limited is, upon information and belief, a company duly organized and existing under the laws of Ireland, with its principal place of business at Setanta House Hotel Clane Road, Celbridge, County Kildare, Ireland.

3. Since July 1966, well before the February 1, 1999 claimed date of first use of the subject mark, Petitioner has continuously used the mark BORA to identify one of its popular liqueurs.

4. Petitioner is the owner of United States Trademark Registration No. 1,272,086, registered March 27, 1984, for the mark “BORA” for liqueur in International Class 33. This registration is valid and subsisting, unrevoked and uncanceled, in full force and effect and has become incontestable pursuant to 15 U.S.C. § 1065.

5. As a result of Petitioner’s long and successful use of its BORA mark, consumers have come to recognize the name and Petitioner’s BORA Sambuca, which is now among the best known, if not the best known such liqueur in this country and had indeed become a famous mark before the February 1, 1999 claimed first use date of Registrant’s BORU mark.

6. By virtue of the long history of Petitioner’s business operations as well as its wide distribution, advertising, and sale of its BORA liqueurs, Distillerie Stock’s BORA mark embodies great and valuable goodwill exclusively belonging to Petitioner. Distillerie Stock’s BORA mark is widely recognized and relied on as identifying Petitioner as the sole source of BORA liqueurs, and as distinguishing the same from the alcoholic beverages of others. Accordingly, Distillerie Stock’s BORA mark is an extremely valuable commercial asset.

7. On or about May 22, 2001, Registrant obtained Registration No. 2,452,996 for the mark BORU in connection with “distilled liquors and distilled spirits” in International Class 33.

8. As initially determined by the Examining Attorney reviewing Registrant’s subject application, the all-but-identical trademarks BORA and BORU for alcoholic beverages are confusingly similar.

9. Contrary to Registrant’s allegations made to secure registration of the mark

BORU that it has made continuing bona fide commercial use of the mark since the alleged date of first use in 1999, Petitioner had never encountered any reference to Registrant's BORU mark in commercial use until shortly before commencing the current proceeding. Upon information and belief, the registration has not been obtained and/or maintained in good faith.

10. Petitioner has been, and will continue to be, damaged by Registration No. 2,452,996, because such Registration provides Registrant with at least prima facie evidence of its exclusive right to use the subject mark. Such evidence will support and assist Registrant in the confusing and misleading use of the subject mark, and will give color of exclusive statutory rights to Registrant in violation and derogation of the prior and superior rights of Petitioner.

11. Registration No. 2,452,996 should be canceled pursuant to Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), on the grounds that Registrant's use of the subject mark falsely suggests a connection between Registrant and Petitioner, to the damage of Petitioner.

12. Registration No. 2,452,996 should be canceled pursuant to Section 14 of the Lanham Act, 15 U.S.C. § 1064(3), on the grounds that Registrant's subject mark is being used by or with the permission of the Registrant so as to misrepresent the source of goods on or in connection with which the mark is used, with consequent injury to Petitioner and to the public.

13. Registration No. 2,452,996 should be cancelled pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the grounds that Registrant's subject mark so resembles Distillerie Stock's BORA mark used consistently by Petitioner in the United States, as to be likely, when used on or in connection with the registered goods, to cause confusion, or to cause mistake, or to deceive, with consequent injury to Petitioner and to the public.

14. Registration No. 2,452,996 should be canceled pursuant to Sections 2(f) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1052(f) and 1125(c), on the grounds that Registrant's use of the

subject mark will dilute the distinctive and famous quality of Distillerie Stock's BORA mark.

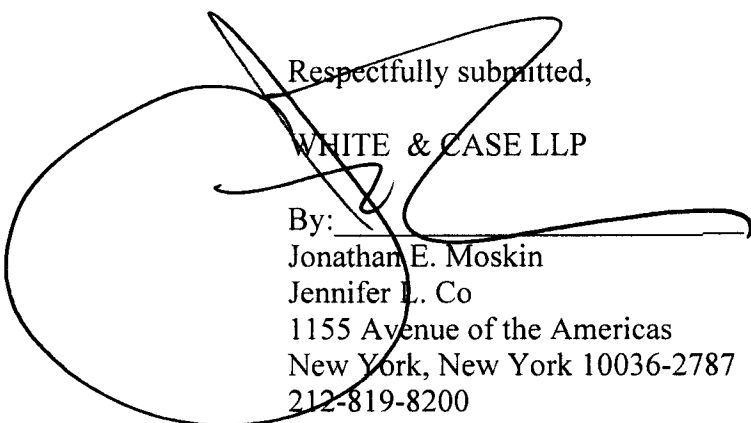
15. Registration No. 2,452,996 should be canceled pursuant to Section 14 of the Lanham Act, 15 U.S.C. § 1064(3), on the grounds that it has been obtained and/or maintained fraudulently.

WHEREFORE, Petitioner respectfully requests that this Petition for Cancellation be sustained and that Registration No. 2,452,996 be cancelled.

This Amended Petition for Cancellation is filed in duplicate as required by 37 C.F.R. § 2.112(a). Pursuant to 37 C.F.R. § 2.6(a)(16).

All communication should be addressed to Petitioner's counsel, White & Case LLP, at the below stated address.

Dated: New York, New York
June 12, 2007



Respectfully submitted,
WHITE & CASE LLP
By: _____
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Attorneys for Petitioner,
Distillerie Stock U.S.A. Ltd.

CERTIFICATE OF SERVICE

I hereby certify that on the 12th day of June, 2007, I served a copy of the foregoing **AMENDED PETITION FOR CANCELLATION** on the attorney for the Respondent, LAWRENCE E. ABELMAN by U.S. FIRST CLASS MAIL.

LAWRENCE E. ABELMAN
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Jonathan E. Moskin